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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,522	07/26/2001	Jin-Kwan Kim	06192.0248.NPUS00	6306

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EXAMINER

COBY, FRANTZ

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 01/28/2004

. Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/912,522	Applicant(s) KIM ET AL.	
	Examiner Frantz Coby	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 2-3, 5-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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This is in response to Applicant's amendment filed on October 30, 2003 in which claims 1-5 were amended.

Status of Claims

Claims 1-10 are pending.

Applicant's arguments filed on the aforementioned date have been fully considered but they are not persuasive. The rejection of claims 1, 4 and 7-10 under section 35 U.S.C. 102(e) paper # 5; mailed July 31, 2003 remains. The rejection of claims 1-3 under 35 U.S.C. 112 2nd paragraph has been withdrawn.

The rejection follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 4 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Sydner et al. U.S. Patent no. 6,038,561.

As per claim 1, Snyder et al. disclose "a method for analyzing and utilizing intellectual property information" by providing a system for analyzing patent texts, such as patent claims, abstracts and other portions of a patent document (See Snyder et al. Abstract). In particular, Snyder et al. disclose the claimed limitations of "registering search strategy formulas for extracting intellectual property information" by providing input search set (item 10 of figure 1 B) which is a text format file of patents to be searched (See Snyder et al. Col. 11, lines 5-7); "accessing and searching internet websites that provide IP information based on the registered search strategy formulas, and extracting first IP information according to the search" through a query processing that manipulates the input data 10 to yield a searchable dataset (See Snyder et al. Figure 9B; Col. 11, lines 7-20). In addition, Snyder et al. disclose the claimed limitations of converting the first IP and second IP information to a standard form and storing the first IP information or converted IP information and transmitting the converted IP information to the research center PCs (See Snyder et al. Col. 13, lines 12-56). Further Snyder et al. disclose accessing the Internet websites and extracting second IP information corresponding to the first IP information (See Snyder et al. Col. 25, line 60-Col. 26, line 21).

As per claim 4, Snyder et al. disclose "an intellectual property IP information extraction unit for extracting IP information according to operation of software form at least one on-line IP information DB found on the Internet or on a network" as a Netscape Browser interface (See Snyder et al. Figure 9A). In particular, Snyder et al. disclose the claimed feature of "an IP information analyzing unit (See Snyder et al. Col. 25, line 40-Col. 26, line 31). Further an Email receiving/transmitting unit is inherent in the Netscape Browser. Especially, the Netscape Browser includes a "Send page" feature that allows E-mail to be received or transmitted.

As per claims 7-8, the aspect of the extraction of IP information has been addressed in the rejection of claim 1 above. Therefore, claims 7-8 are rejected as set forth above.

As per claim 9, the aspect of the "IP information analyzing" unit has been addressed in the rejection of claim 4 above. Therefore, claim 9 is rejected as set forth above.

As per claim 10, the aspect of the E-mail receiving/transmitting unit has been addressed in the rejection of claim 4 above. Therefore, claim 10 is rejected as set forth above.

Allowable Subject Matter

Claims 2-3 and 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record failed to teach the aspect of IP information that includes technical analysis and technical classifications.

Remarks

The Applicant argued, "There is no concept of requesting detailed information for the IP information previously searched and extracted from the websites". However, the Examiner respectfully disagrees with the preceding argument. In Sydnor, a search is registered by providing a mechanism that enables a user to enter in English text a description of a concept query which the system will search for in the database patents. When the search query is initiated, in Sydnor, the **first access** is achieved when the query is processed on a database over the World Wide Web and a response is returned displaying a list of patents. The Applicant should duly note that Sydnor provides the Netscape NetBrowser interface so that a user can access IP information such as Patents over the Internet. In Sydnor, **second access** is achieved by a user clicking on one of the patents on the returned list of patents, this is request for detailed information, where the database is again access over the World Wide Web for displaying of the

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entire text of the patent that was clicked on. Therefore, Sydner disclose the concept of accessing Internet websites twice when a request for detailed information is made.

The Applicant further argued, "There is no concept of searching Internet websites for IP information". The Examiner respectfully disagrees because Sydner provides the Netscape NetBrowser interface so that a user can access IP information, such as Patents, over the Internet. Also, It would be apparent from Sydner's use of the Netscape NetBrowser that Internet websites must be access when a query is entered since the Netscape NetBrowser is for interfacing with the World Wide Web.

Last, the Applicant argued that "Sydner fail to disclose the claimed feature" of "an Email receiving/transmitting unit for receiving feedback of data containing opinion contents from the research center PC's". However, the Examiner disagrees with this line of argument because an Email receiving/transmitting unit is inherent in the Netscape Netbrowser interface. Also, it would be apparent from Sydner's use of the Netscape Netbrowser that an Email receiving/transmitting unit must be incorporated to effectively permit messages to be transmitted or received over the Internet.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Monday - Friday from 10:30AM -10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.

Frantz Coby


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Frantz Coby
Primary Examiner
Art Unit 2171

January 23, 2004